Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

REMARKS

I.   Introductory Comments

Claims 1, 3, and 5-34 were previously pending in the application. Claims 1, 22, 29, and 33 are independent claims. No claims have been amended, canceled, or added. Therefore, claims 1, 3, and 5-34 remain pending.

In the Final Office Action, the Examiner rejected claims 1, 3, and 5-28 under 35 USC § 101 as allegedly directed to non-statutory subject matter. The Examiner rejected claims 1, 3, 5, 8-19, and 22-32 under 35 USC § 103(a) as being unpatentable over the combination of various instances of the Examiner's Official Notice (see, e.g., pages 3, 12, 15, 19, and 21 of the Office Action) in view of **Roth** (Philip L. Roth & Philip Bobko, *A Research Agenda for Multi-Attribute Utility Analysis in Human Resource Management*, 7 Hum. Resource Mgmt. Rev. 3, 341-368 (1997)), **Edwards** (Jeffrey R. Edwards & Mark E. Parry, *On the Use of Polynomial Regression as an alternative to Difference Scores in Organizational Research*, 36 Acad. of Mgmt. J. 6, 1577-1613 (Dec., 1993)), and further in view of **Trocine** (Linda Trocine & Linda Malone, *Finding Important Independent Variables Through Screening Designs: A Comparison of Methods*, Proc. of the 2000 Winter Simulation Conf., 749-754 (2000)). Claims 6-7, 20-21, and 33-34 were rejected under 35 USC § 103(a) as being unpatentable over the combination of the Examiner's Official Notice (used to reject a preceding base claim) in view of Roth, Edwards, Trocine, and in further view of Jacobson (Tom Jacobson, *Reaching New Heights*, 22 Credit Union Mgmt., Madison 6 (June 1999)).

In view of the following arguments, all claims are believed to be in condition for allowance. Therefore, this response is believed to be a complete response to the Final Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of dependent claims not explicitly addressed herein, in future papers.[1]

---

1. As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references,

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

II.   Claims 1, 3, and 5-28 Are Directed to Statutory Subject Matter Under Section 101.

In the previous Office Action, the Examiner rejected claims 1-28 under Section 101, stating that the claims were non-statutory because they could be performed within the human mind. Although Applicants disagreed with the Examiner's assessment, independent claims 1 and 22 were amended to address the Examiner's concerns. Independent claims 1 and 22, as previously amended, clearly recite and are "tied to" devices, and are therefore directed to statutory subject matter, even under the "machine-transformation" test. Specifically, independent claims 1 and 22 are each directed to a "computer implemented method," and each further recites "storing employee task data in a database of a computing system." Claim 1 further recites "analyzing said productivity scores . . . utilizing said computing system." Claim 22 further recites "applying linear regression techniques to said productivity scores utilizing the computing system."

In the Final Office Action, the Examiner maintained the Section 101 rejection. Specifically, the Examiner stated that the claims are directed to non-statutory subject matter because "[t]he *main parts* of the method claim, ie. the generating, selecting, performing, analyzing and applying steps fail to positively recite a tie to a particular machine or apparatus." (Final Office Action, page 2, emphasis added.) The Examiner did not cite any case law to support the notion that the "main parts" of a claim must be tied to a machine or apparatus under Section 101. Further, Applicants are unaware of any such requirement. The Court of Appeals for the Federal Circuit in *In re Bilski* (2007-1130 (Fed. Cir. Oct. 30, 2008)) stated that "[a] claimed process is *surely* patent-eligible under § 101 if: (1) *it is tied to a particular machine or apparatus*." (*Bilski* at 24, emphasis added.) The court did not state that the "main parts" of a claim be tied to a machine.

Further, even if *Bilski* did require that the "main parts" of a claim be tied to a machine, which it does not, contrary to the Examiner's assertion, both claims are tied to devices in those portions that the Examiner identified as the "main parts" of each claim. For example, claim 1

---

assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

recites "analyzing said productivity scores . . . utilizing said computing system," and claim 22

recites "applying linear regression techniques to said productivity scores utilizing the computing

system." Thus, independent claims 1 and 22 are clearly directed to statutory subject matter, even

under the Examiner's "main parts" theory of statutory subject matter. Dependent claims 3, 5-21,

and 23-28 depend from independent claims 1 and 22, and are therefore also directed to statutory

subject matter. Therefore, for at least the reasons stated above, the Examiner's Section 101

rejection has been fully addressed and should be withdrawn.

III.   The Examiner's Official Notice is Improper.

The Examiner has continued to rely on Official Notice to reject every pending claim.

Applicants have repeatedly challenged each use of Official Notice and repeatedly requested the

Examiner to provide documentary evidence to support each instance of Official Notice. Each

instance of Official Notice is still improper, as the Examiner has not provided any evidence to

support even one instance of Official Notice. Thus, the Section 103 rejections cannot be

sustained unless the Examiner provides the required documentary evidence.

A.   The Examiner Must Support Each Instance of Official Notice.

Instead of supporting the numerous instances of Official Notice, the Examiner has boldly

alleged that the burden is on the Applicants to "provide [] evidence as to why the facts that are

the subject of the Official Notice are not, in fact, old and well known." (Final Office Action,

page 2.) Applicants cannot prove a negative, and certainly cannot provide evidence that

something was not "old and well known." Further, it is not the Applicants burden to provide

evidence to dispute the Examiner's Official Notice, unless the Examiner actually provides the

required documentary evidence to support the Official Notice in the first place. Under the

Examiner's interpretation of Official Notice, the Examiner could simply take Official Notice that

the entire claim is "old and well known," and require Applicants to prove otherwise. Such an

interpretation clearly contradicts the explicit requirements of the CFR and MPEP that require an

Examiner to support an instance of Official Notice if challenged.

The MPEP and the CFR are clear that the Examiner is *required* to support each instance

of Official Notice when challenged. For example, 37 CFR § 1.104(d)(2) clearly states that the

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

Examiner is required to provide an affidavit to support the Official Notice. "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, *and the reference must be supported, when called for by the applicant*, by the affidavit of such employee." (37 CFR § 1.104(d)(2).) Thus, without providing any evidence, the rejections relying on Official Notice must be withdrawn.

B. No Instance of Official Notice is Admitted Prior Art.

The Examiner alleged that "[t]he MPEP is clear that once Official Notice is taken, the burden is on the applicant to point out <u>why</u> the subject of Official Notice is not old and well known." (Final Office Action, page 2, emphasis in original.) MPEP Section 2144.03(C) is entitled "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, *the Examiner Must Support the Finding With Adequate Evidence*." (MPEP § 2144.03(C), emphasis added.) Challenging Official Notice by requesting documentary support is an adequate and proper traversal of an Examiner's reliance on Official Notice as discussed in Section 2144.03(C). Thus, the Examiner is required to either support each instance of Official Notice with documentary support, or withdraw every Section 103 rejection which relies on Official Notice.

C. Official Notice Is Not Limited to the Two Explicitly Stated Instances.

The Examiner stated that the taking of Official Notice was limited to two very broad statements. However, the Examiner has taken Official Notice in at least four other instances. The Examiner alleged that Official Notice was limited to the following:

(1) "that it is old and well known to remove outliers from a probabilistic distribution," and

(2) "that it is old and well known in an organization for individuals to perform different tasks."

(Final Office Action, page 2.) However, the Examiner used at least 4 other instances of Official Notice, all of which are unsupported by any documentary evidence. For example, the Examiner disagreed with Applicants argument that the cited references fail to teach "storing

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task," as recited in claim 1. However, the Examiner then simply took Official Notice that "storing data in a database, while not explicitly taught by the references, is old and well known." (Final Office Action, page 3.) The Examiner then alleged that the remainder of the claim was nonfunctional and therefore irrelevant.

Dependent claim 9 recites that "said sets of task scores are scaled to represent performance by employees over a common work period, with a fixed number of hours worked." Regarding claim 9, the Examiner took Official Notice that "using such a measure is known in the art to provide normalization, i.e. a standardization of what time workers work such that a comparison can be made between the amount of work achieved." (Final Office Action, page 19.)

The Examiner also took Official Notice regarding claim 11 that "it is old and well known in the art to determine and remove anomalous data points for the purpose of improving accuracy of results in an analysis." (Final Office Action, page 21.) Regarding claim 29, the Examiner took Official Notice that "performing the method steps taught by Roth and Edwards using computer software running on a computer system is old and well known in the art." (Final Office action, page 23.)

Applicants do not acquiesce to any instance of Official Notice, and once again request that the Examiner specifically acknowledge each instance of Official Notice and provide the required documentary evidence to support each taking of Official Notice.

D. The Two Explicit Instances of Official Notice Are Improper.

The Examiner stated that the taking of Official Notice was limited to the following: (1) "that it is old and well known to remove outliers from a probabilistic distribution," and (2) "that it is old and well known in an organization for individuals to perform different tasks." (Final Office Action, page 2.) These two instances of Official Notice are improper as being nothing more than overbroad generalizations. Both statements are so overbroad that neither is applicable to Applicants' claims, nor could such overbroad statements be properly combined with the cited references, as discussed in more detail below.

15

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

Therefore, the Examiner must provide appropriate evidence in the next Office Action, or withdraw the obviousness rejections of every pending claim. Furthermore, the required documentary evidence must also comply with the rules and laws of obviousness if the Examiner intends to maintain the obviousness rejections. For example, the Examiner must show that the required documentary evidence can be properly combined with the other cited references to maintain the stated obviousness rejections.

IV.   Independent Claim 1 Is Patentable Over The Cited References.

In the Final Office Action, claim 1 was rejected under Section 103(a) as being unpatentable over the Examiner's Official Notice in view of Roth, Edwards, and further in view of Trocine. As discussed above, the Examiner must provide appropriate documentary evidence to support each instance of Official Notice or withdraw the rejection. As discussed in detail below, Roth clearly fails to teach or suggest numerous recitations found in Applicants' claims. Further, none of the other cited references compensate for the acknowledged deficiencies of Roth. In addition, there is certainly no motivation to combine the references.

   A.   *"storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task."*

None of the cited references, including Roth, teach or suggest the identified recitation. For this reason alone, claim 1 is patentable over the cited references. The Examiner alleged that Roth teaches the identified recitation. However, the Examiner dismissed the identified recitation by taking Official Notice and further alleging that the remainder of the recitation is irrelevant as "nonfunctional." Clearly none of the cited references teach or suggest the identified recitation. Further, the recitations of "said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task" cannot simply be ignored.

Specifically, the Examiner stated that "[t]he particular type of data that is claimed does not distinguish over the type of data claimed, because the method steps would be performed the same way." (Final Office Action, page 3.) The Examiner then cited *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Gir. 1983); *In re Lowry*, 32 F.3d 1579, 32 (Fed. Gir. 1994); and MPEP § 2106.

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

However, MPEP Section 2106 covers patentable subject matter eligibility under Section 101. Where the MPEP mentions *In re Gulack and In re Lowry*, the MPEP actually states that all claim recitations must be considered in view of the cited references, and thus cannot simply be ignored.

MPEP Section 2106.01 clearly states that "USPTO personnel **must** consider **all claim limitations** when determining patentability of an invention over the prior art." (MPEP § 2106.01, emphasis added.) Thus, contrary to the Examiner's assertion, the identified claim recitations must be considered. Previously, Applicants argued that Roth fails to teach or suggest "storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task." The Examiner disagreed, but instead of showing how Roth teaches the identified recitation, the Examiner took Official Notice that "storing data in a database, while not explicitly taught by the references, is old and well known." (Final Office Action, page 3.) Clearly claim 1 recites more than simply "storing data in a database," and thus the Examiner's Official Notice fails to compensate for the acknowledged deficiencies of the cited references.

The Examiner alleged that "the references do teach manipulating and analyzing employee data," but failed to show how or where any of the cited references include any such disclosure. (Final Office Action, page 3.) The Examiner then simply alleged that the remaining recitations, i.e., that "said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task," were irrelevant. The Examiner alleged that "[t]he particular type of data that is claimed does not distinguish over the type of data claimed, because the method steps would be performed the same way." (Id.) Further, the Examiner alleged that "the type of data recited here is nonfunctional," and thus can simply be ignored. (Final Office Action, page 8.)

However, portions of the claim cannot simply be ignored by alleging that "the type of data . . . is nonfunctional." As previously discussed, the Examiner must consider all claim recitations. Clearly, Roth says nothing at all about "employee task data," and clearly fails to teach or suggest "storing employee task data in a database." In addition, none of the cited references or the Examiner's Official Notice compensate for the deficiencies of Roth.

17

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

B. *"generating sets of task scores based on a selected model design of task assignments utilizing said employee task data."*

In the previous Office Action, the Examiner alleged that Roth teaches "generating sets of task scores based on a selected model design of said task assignments" in a section entitled "Constructing Measures" on page 352. In the Final Office Action, the Examiner alleged that Roth teaches the identified recitation in a section entitled "The Need for Multi-Attribute Utility" on page 343. (Final Office Action, page 3.) Further, the Examiner alleged that "Roth teaches generating task scores (eg. Interview and cognitive test) as part of multiattribute analysis (MAU)." (Final Office Action, page 8.) However, Roth says nothing about "employee task data," let alone "generating sets of task scores based on a selected model design of task assignments utilizing said employee task data," as recited in claim 1.

Roth is directed to a method of analyzing a potential human resource management decision, which Roth describes as a method "to help guide decision making and estimate the value of Human Resource Management (HRM) interventions." (Roth at 341.) Roth notes that "[m]ost applications of utility analysis in Human Resource Management have focused upon only one outcome of a selection system – the value of job performance in dollars. Multi-attribute utility (MAU) analysis allows decision makers to incorporate multiple outcomes into their analytic decisions." (Id.) Further Roth states that "[multi-attribute utility analysis] may be defined as a set of procedures to guide decision making that integrate multiple outcomes from a course of action into a single number that represents the usefulness of that course of action." (Roth at 342.)

On page 343, Roth analyzes a hypothetical potential human resource decision involving hiring new sales managers. Roth states that "an HRM [human resource management] department may be interested in hiring 25 district sales managers," for example, by "using either a cognitive ability test or a structured behavioral interview." (Roth at 343.) Clearly the cited portion of Roth fails to teach or suggest "generating sets of task scores based on a selected model design of task assignments utilizing said employee task data," as recited in claim 1. As previously discussed, Roth says nothing at all about "employee task data," and therefore clearly

Application No. 10/699,141
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

Docket No.: 03-8012

fails to teach or suggest "generating sets of task scores . . . utilizing said employee task data," as recited in claim 1.

In the paragraph cited by the Examiner on page 343, Roth states that "[u]se of a MAU approach requires combining the various attributes important to decision makers. This can be accomplished by developing a set of functions that weight each attribute and combining the attributes into a single metric." (Roth at 343.) The Examiner alleged that Roth teaches "generating sets of task scores based on a selected model design of task assignments utilizing said employee task data" by allegedly teaching "a model of measuring employee performance based on a cognitive test and interview." (Final Office action, page 4.) However, Roth says nothing at all about "generating sets of task scores." The Examiner equated "employee task data" with "how the employees performed in the above tests." (Id.) However, Roth actually discusses measuring how a hiring decision should be analyzed, and says nothing at all about "how the employees performed" in the interview tests.

C. *"selecting a centralized composite design as said model design."*

The Examiner acknowledged that Roth fails to teach or suggest the identified recitation on page 8 of the Final Office Action, and cited Trocine for the deficiencies of Roth. (Final Office Action, page 8.) First, the Examiner quoted the following passage of Roth:

> MAU also increases the participation of decision makers in the utility analysis process by asking them what factors to consider, how to measure the factors, and what functions should be used to combine them.

(Roth at 341.) The Examiner then alleged that "[f]rom this passage *it is implied* that an issue in constructing an MAU is identifying 'what factors to consider.'" (Final Office Action, page 5, emphasis added.) Next, the Examiner stated that "[p]art of the answer in identifying what factors to consider is provided by Trocine." (Id.)

However, it is clear from the cited passage that Roth is seeking a broad range of input on a wide range of issues affecting a decision, and is seeking that input from "decision makers." Roth is not discussing "selecting a centralized composite design as said model design," as recited in claim 1. Notably, a "model design" refers in part to "generating sets of task scores based on a

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

selected model design of task assignments utilizing said employee task data," as also recited in claim 1. Clearly Roth's disclosure of seeking input from decision makers as to "what factors to consider, how to measure the factors, and what functions should be used to combine them" is clearly distinguishable from "selecting a centralized composite design as said model design," as recited in claim 1. In addition, Trocine fails to compensate for the acknowledged deficiencies of Roth.

Trocine is directed to designing experiments, and more specifically to "finding important independent variables through screening designs" for use in "a simulation model or [a] production system." (Trocine at 749.) Notably, Trocine states that "[t]hese important variables can later be used to optimize the [simulation] model." "Simulation models typically represent complex and stochastic systems. Experimentation on these systems is assumed to be time consuming and can be expensive in terms of computation. Minimizing the number of experiments while maximizing information is the ultimate goal." (Id.) Clearly Trocine is neither applicable to the teachings of Roth, nor to Applicants' claims.

The Examiner alleged that "Trocine teaches what is known in the art about factorial designs (a factorial design is a centralized composite design) where this analytic approach allows a decision maker to identify which variables in a model are significant." (Final Office Action, page 5.) However, neither Roth nor Trocine say anything at all about "selecting a centralized composite design as said model design," as recited in claim 1. Further, Trocine is clearly not directed to Roth or Applicants' claims, and thus cannot be combined with Roth. Even if Trocine and Roth were combined as alleged by the Examiner, the combination still fails to teach "selecting a centralized composite design as said model design." Nor is there any motivation or suggestion to combine Roth and Trocine.

The Examiner alleged that combining the alleged teachings of Trocine with Roth "allows a decision maker to identify which variables in a model are significant. This would be important to a person of ordinary skill in the art attempting to use MAU . . . because it would provide insight into what variables would have an impact on employee performance." (Final Office Action, page 5.) However, Roth specifically teaches asking decision makers for their input

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

regarding which factors to use, as discussed in the portion cited by the Examiner. For example, Roth states that "MAU also increases the participation of decision makers in the utility analysis process by asking them what factors to consider, how to measure the factors, and what functions should be used to combine them." (Roth at 341.) Further, Trocine is directed to designing experiments and finding important independent variables through screening designs for use in a simulation model. Clearly Roth says nothing at all about using experiments to determine which factors to use in a human resource management decision. Thus, there is clearly no motivation to combine the alleged teachings of Trocine with Roth.

   D. *"performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores."*

   Applicants previously argued that Roth fails to teach the identified recitation. The Examiner disagreed and stated that "MAU as taught by Roth evaluates individual performance (e.g. the cognitive test and interview per above) to determine what the scores are for that performance (i.e. assigning productivity scores to the task scores." (Final Office Action, page 6.) Specifically, the Examiner alleged that Roth teaches the identified recitation in a section entitled "The Need for Multi-Attribute Utility." (Final Office Action, page 11.) However, as previously discussed, Roth says nothing at all about "assigning productivity scores" or any "task scores." In fact, Roth says nothing about scoring how an employee performed during an interview, let alone "performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores," as recited in claim 1.

   As previously discussed, in the portion cited by the Examiner, Roth analyzes a hypothetical potential human resource decision involving a process to interview job candidates. However, nowhere in the disclosure cited by the Examiner does Roth teach or suggest "performing a plurality of evaluations of said sets of task scores," nor does Roth even mention "assigning productivity scores," as recited in claim 1.

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

E. *"analyzing said productivity scores to determine productivity parameters,
wherein analyzing said productivity scores comprises applying linear
regression techniques to said productivity scores utilizing said computing
system."*

The Examiner previously argued that Roth taught the identified recitations. The
Examiner is now relying on a combination of Roth, Edwards, and Trocine to reject this recitation
of claim 1. However, even the combination of Roth, Edwards, and Trocine fails to teach or
suggest the identified recitation of claim 1.

The Examiner stated that "Roth teaches that an individual's performance can be
measured by a weighted combination of scores for tasks that they perform." (Final Office
Action, page 6.) However, Roth includes no such disclosure as Roth says nothing about using "a
weighted combination of scores for tasks that they perform." The Examiner also stated that on
page 353 Roth teaches that "the combination of the attributes into a single score requires
analyzing the scores to determine the weights (i.e. productivity parameters) for how they are
combined." (Final Office Action, page 11.) The Examiner appears to be relying on some
alleged inherent disclosure of Roth as Roth fails to teach or suggest "analyzing the scores to
determine the weights (i.e. productivity parameters)." To the extent that the Examiner is relying
on some alleged inherent disclosure of Roth, Applicants request that the Examiner specifically
address how and why such disclosure is inherent.

In the cited portion, Roth discusses "develop[ing] a series of utility functions," where
"[o]ne function is needed for each indicator so that all the indicator values can be combined into
a single composite number expressing the benefits of each decision option." (Roth at 353.)
However, Roth says nothing at all about "productivity scores," "productivity parameters," or
"applying linear regression techniques to said productivity scores," as recited in claim 1.
Further, the Examiner did not identify which part of the claim recitation that Roth fails to teach,
but alleged that "Trocine provides an indication of what type tasks [sic] should be included in the
combination." (Final Office Action, page 6.) Trocine includes no such disclosure, and the
Examiner did not cite any portion of Trocine to support the allegation. The Examiner then cited
Edwards for the deficiencies of Roth and Trocine, and stated the following:

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

Edwards provides what is known in the art about multivariate regression, which is a technique for determining an equation in more than one variable, where the weights or coefficients for those variables (i.e. determining productivity parameters) is determined through the statistical analysis provided by multivariate regression."

(Final Office Action, pages 6-7.) However, Roth clearly fails to mention a need for any additional mathematical analysis technique, let alone "multivariate regression." Notably, Roth states that the "use of a MAU approach requires combining the various attributes . . . [by] developing a set of functions that weight each attribute and combin[e] the attributes *into a single metric*." (Roth at 343, emphasis added.) Once combined into a single metric, there is no need to perform any multivariate regression, and there is no reason to combine the teachings of Edwards with Roth.

F. *"applying said productivity parameters to employee task scores for said employees to obtain said performance measures for said employees"*

The Examiner previously argued that Roth taught the identified recitation. The Examiner is now relying on a combination of Roth, Edwards, and Trocine to reject this recitation of claim 1. However, even the combination of Roth, Edwards, and Trocine fails to teach or suggest the identified recitation of claim 1.

The Examiner alleged that Roth teaches that "one of the tasks with MAU is to combine various scores using weights," and the Examiner further alleged that "[i]t has been clearly shown that Trocine teaches what variables to measure and Edwards teaches how to use statistical techniques to determine the weights to use with MAU in combining the individual's scores." (Final Office Action, page 7.) However, as previously discussed, the cited references fail to even mention "productivity parameters" or "employee task scores," let alone teach or suggest "applying said productivity parameters to employee task scores for said employees to obtain said performance measures for said employees," as recited in claim 1.

The Examiner admitted that "Roth does not teach where the evaluation method is for evaluating different employees who are performing different tasks." (Final Office Action, page 12.) The Examiner then took Official Notice that "it is old and well known in the art for

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

individuals in an organization to perform different tasks." (Id.) However, as previously discussed, the Examiner's Official Notice is inappropriate and should be withdrawn. The Examiner's Official Notice is overbroad, vague, and fails to address the specific recitation in Applicants' claims.

The Examiner's Official Notice is so overbroad as it cannot possibly relate to Applicants' claims. Individuals within an organization *may or may not* perform different tasks, *may or may not* be required to perform such different tasks, and *may or may not* be evaluated based on their performance of differing tasks. Generalizing that individuals perform different tasks ignores the complexity of an employee's role in an organization, and further ignores the complexities of analyzing employee performance. However, the Official Notice, even if accepted as prior art, fails to teach or suggest "applying said productivity parameters to employee task scores for said employees to obtain said performance measures for said employees," as recited in claim 1. Further, neither the Examiner's Official Notice, nor Roth or Trocine, includes any suggestion or motivation to modify the teachings of Roth to render the identified recitation obvious.

The Examiner stated that

> Since Roth teaches using different utility functions that are combined to represent different factors as an input into productivity, it would have been obvious . . . to modify those teachings to include applying the utility function idea to the different tasks performed by different employees, because it would provide a way to provide a comparative measure of different employee's contributions to a firm's productivity, thus improving the ability of the firm to value different employees.

(Final Office Action, page 12.) However, the Examiner is simply using Applicants' claims as a road map to form the obviousness rejection. The Examiner reasoned that this drastic modification to Roth would have been obvious "because it would provide a way to provide a comparative measure of different employee's contributions to a firm's productivity, thus improving the ability of the firm to value different employees." (Final Office Action, page 12.) The Examiner is using Applicants' claims as both a road map and as a motivation to modify the teachings of Roth to perform the recitations of Applicants' claims. The Examiner's reasoning

Application No. 10/699,141
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

Docket No.: 03-8012

appears circular – it would be obvious to modify Roth to perform Applicants' claimed recitations because it could then perform Applicants' claimed recitations.

For at least the foregoing reasons, independent claim 1 is patentable over the Examiner's Official Notice and the cited references. Thus, Applicants respectfully request the Examiner to withdraw the rejection of independent claim 1, as well as claims 3 and 5-21 depending therefrom.

V. Independent Claim 22 Is Patentable Over the Cited References.

The Examiner rejected independent claim 22 under Section 103(a) as being unpatentable over the combination of Official Notice, Roth, Trocine, and Edwards. As discussed above, the Examiner must provide documentary evidence to support the Official Notice or withdraw the rejection. Furthermore, the cited references fail to teach or suggest numerous recitations found in independent claim 22. In addition, there is no motivation to combine the references.

Independent Claim 22

Claim 22 reads:

> A computer implemented method of determining productivity parameters for evaluating employee performance for employees having differing task assignments, comprising:
> storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task;
> generating sets of task scores based on a selected model design of task assignments utilizing said employee task data;
> selecting a centralized composite design as said model design;
> performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores; and
> applying linear regression techniques to said productivity scores utilizing the computing system to obtain said productivity parameters using an expression having a form

$$PS_i(F_{i1}, F_{i2}, ..., F_{iK}) = \alpha_i + \sum_{k=1}^{K} \beta_{ik} F_{ik} + \sum_{k=1}^{K} \sum_{k'=1}^{K} \gamma_{ikk'} F_{ik} F_{ik'}, \text{ where}$$

25

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

F_{tk} is a measured value for a k task of assignment t,

PS_t is a productivity score for said assignment t as a function of said measured values, F_{t1}, F_{t2}, ... F_{tK}, and

α_t, β_{tk} and γ_{tkK}· are said productivity parameters.

The Examiner alleged that "[c]laim 22 recites similar limitations to those addressed by the rejection of Claims 2 and 3 . . . and are [sic] therefore rejected under the same rationale." (Final Office Action, page 22.) However, Claim 22 is not identical to claims 2 and 3. As discussed in detail above regarding claim 1, Roth fails to teach or suggest multiple recitations found in claim 22. Furthermore, the Examiner's reliance on Official Notice is inappropriate.

For example, as discussed above, none of the cited references, whether viewed alone or in combination, teach or suggest any of the following:

storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task;

generating sets of task scores based on a selected model design of task assignments utilizing said employee task data;

selecting a centralized composite design as said model design;

performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores; and

applying linear regression techniques to said productivity scores utilizing the computing system to obtain said productivity parameters.

Thus, for at least the reasons setting forth the patentability of claim 1, independent claim 22 is patentable over the cited references. Thus, Applicants respectfully request the Examiner to withdraw the rejection of independent claim 22, as well as claims 23-28 depending therefrom.

VI.   Independent Claims 29 Is Patentable Over the Cited References.

The Examiner rejected claim 29 under Section 103(a) based on the combination of the Examiner's Official Notice, Roth, Edwards, and Trocine. More specifically, the Examiner alleged that "[c]laim 29 recites similar limitations to those addressed by the rejection of Claim 22

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

above by Roth, and is therefore rejected under the same rationale." (Final Office Action, page

23.) The Examiner admitted that

> Roth and Edwards do not explicitly teach performing his [sic]
> method using computer readable medium containing instructions
> for causing a computer system to perform method steps, however
> Official Notice is taken that performing the method steps taught by
> Roth and Edwards using computer software running on a computer
> system is old and well known in the art.

(Id.) However, claim 29 is not identical to claim 22. Furthermore, as discussed in detail above,

the Examiner's reliance on Official Notice is inappropriate, and the Examiner must provide

documentary evidence to support each instance of Official Notice, or withdraw the rejection.

Also, as discussed in detail above regarding independent claims 1 and 22, the cited references,

whether viewed alone or in combination, fail to teach or suggest multiple recitations found in

independent claim 29. Thus, for at least the reasons setting forth the patentability of independent

claims 1 and 22, independent claim 29 is patentable over the cited references. Thus, Applicants

respectfully request the Examiner to withdraw the rejection of independent claim 29, as well as

claims 30-32 depending therefrom.

VII.   Independent Claims 33 Is Patentable Over the Cited References.

The Examiner rejected claim 33 under Section 103(a) based on the combination of the

Examiner's Official Notice, Roth, Edwards, Trocine, and Jacobson. (Final Office Action, page

24.) More specifically, the Examiner alleged that "[c]laim 33 recites similar limitations to those

addressed by the rejection of Claim 6 above by Roth and Jacobson, and is therefore rejected

under the same rationale." (Final Office Action, page 26.) However, claim 33 is not identical to

claim 6. Furthermore, as discussed in detail above, the Examiner's reliance on Official Notice is

inappropriate, and the Examiner must provide documentary evidence to support each instance of

Official Notice, or withdraw the rejection. In addition, as discussed in detail above regarding

independent claims 1 and 22, the cited references fail to teach or suggest multiple recitations

found in independent claim 33. Thus, for at least the reasons setting forth the patentability of

claims 1 and 22, independent claim 33 is patentable over the cited references. Thus, Applicants

Application No. 10/699,141   Docket No.: 03-8012
Early Response to Final Office Action dated July 28, 2009
Reply to Office Action of May 29, 2009

respectfully request the Examiner to withdraw the rejection of independent claim 33, as well as claim 34 depending therefrom.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested, and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013 under order number 65632-0559. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: July 28, 2009   Respectfully submitted,

                                                        Electronic Signature: /Justin S. Cohen/
                                                        Michael B. Stewart
                                                            Registration No.: 36,018
                                                        Justin S. Cohen
                                                            Registration No.: 59,964
                                                        RADER, FISHMAN & GRAUER PLLC
                                                        Correspondence Customer Number: 25537
                                                        Attorneys for Applicants